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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,153	10/28/2003	Eric M. Lunsford	PALM-0933	6590

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EXAMINER

MYERS, PAUL R

ART UNIT PAPER NUMBER

2112

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/696,153	Applicant(s) LUNSFORD ET AL.	
	Examiner Paul R. Myers	Art Unit 2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) * | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 11-14 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 5-7 respectively of prior U.S. Patent No. 6,523,124. This is a double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-10 and 15-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,523,124.

Although the conflicting claims are not identical, they are not patentably distinct from each other

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because the pending claims merely remove limitations of the allowed claims. See *In re Emert* No. 96-1559 U.S. CAFC 44 U.S.P.Q.2D (BNA) 1149.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-10, 15-24 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Pleso PN 5,859,970.

In regards to claim 1: Pleso discloses a method for operating a portable computing device (portable electronic device), the method comprising: coupling a signal line accessible through an outlet (an electrical connector) of the portable computing device to a communication device(docking station Column 2 lines 40-43); detecting a signal on the signal line to determine whether the communication device is actively connected to a portable computing device (e.g.

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detecting power received by the portable device from the docking station Column 2 lines 45-48, Column 6 line 59 to Column 7 line 15), and suspending execution of at least a portion of a program the portion of the program reducing power consumption of the portable computing device (switches from low power consumption mode to an active full power mode Column 2 lines 49-50).

In regards to claims 2 and 17: Pleso teaches suspending execution of a portion of a program for reducing power consumption includes suspending of a timeout feature (Column 2 lines 49-50).

In regards to claim 3: Pleso teaches sending communications from the portable computing device using the communication device when the communication device is actively connected to the portable computing device (Column 2 lines 45-47, Column 5 lines 9-42).

In regards to claims 4 and 18: Pleso teaches coupling a signal line including extending the signal line to a pin connector forming the outlet (Column 5 lines 9-26).

In regards to claims 5 and 19: Pleso teaches selectively suspending the occurrence of the time-out feature when the portable computing device is actively coupled (selectively switchable from low power consumption mode to full power mode Column 6 lines 45-58).

In regards to claims 6 and 20: Pleso teaches suspending execution of at least a portion of a program for reducing power consumption of the portable computing device includes disabling the time-out feature while the communication device is actively coupled (Column 6 lines 45-58).

In regards to claims 7 and 21: Pleso teaches detecting the signal includes measuring a voltage level of the signal (Column 7 lines 1-16).

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In regards to claims 8 and 22: Pleso teaches detecting a signal from the communication device includes coupling the portable computing device to the communication device using a pin connector, and wherein one pin in the pin connector extends into the signal line (Column 5 lines 9-27).

In regards to claims 9 and 23: Pleso teaches launching a program that is downloaded to the portable computing device through the communication device once the occurrence of the time-out feature is suspended (Column 5 to Column 6 line 43).

In regards to claims 10 and 24: a plurality of images are within the teachings of Pleso in that Pleso discloses a display 14 for displaying any information downloadable through the LAN or stored in the memory of the portable computing device (Column 1 and Column 6).

In regards to claim 15: Pleso teaches a detachable assembly, comprising: a communication device (docking station); a portable computing device (portable device 10) adapted to couple to the communication device, the portable computing device including a signal line that is adapted to couple to an output node of the communication device (output connector), a processor 68 or detector circuit 88 coupled to detect a signal on the signal line to determine whether the communication device is actively connected to the portable computing device, wherein the processor is programmed to suspend execution of at least a portion of a program upon detecting the communication device, the portion of the program reducing power consumption of the portable computing device (Column 8 lines 15-24).

In regards to claim 16: Pleso teaches communication device includes an alternating current adapter for supplying power to the portable computing device (Column 8 lines 56-65).

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In regards to claim 29: Pleso teaches a portable computing device (portable electronic device), comprising: means for coupling a signal line accessible through an outlet (an electrical connector) of the portable computer device to a communication device (docking station Column 2 lines 40-43); means for detecting a signal (detector) on the signal line to determine whether the communication device is actively connected to a portable computing device (e.g. detecting power received by the portable device from the docking station Column 2 lines 45-48 and Column 6 line 59 to Column 7 line 15); means for suspending execution of at least a portion of a program, the portion of the program reducing power consumption of the portable computing device (switches from low power consumption mode to an active full power mode Column 2 lines 49-50).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 703 305 9656. The examiner can normally be reached on Mon-Thur 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703 305 4815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Paul R. Myers". The signature is fluid and cursive, with a long, sweeping underline.

PRM
September 28, 2004

PAUL R. MYERS
PRIMARY EXAMINER